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09/617,593	07/18/2000	Reto Stamm	X-677 US	9386

7590 04/29/2005
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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/617,593	STAMM ET AL.	
	Examiner	Art Unit	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/7/04, and has been entered and made of record. Currently, **claims 1-5, 7-16 and 18-21** are pending.

Response to Arguments

2. Applicant's arguments filed 10/7/04 have been fully considered but they are not persuasive.

In response to applicant's argument regarding the rejection of **claims 12-15 and 18-20**, wherein on pages 7-10, the applicant explains how the current invention differs from the teaching of Mucciolo. Particularly, the applicant states that the current invention has, for example, reformatting the presentation as a miniature presentation having the size of a business card. The examiner respectfully disagrees with the applicant. As it was previously presented in the previous Office action dated 7/2/04, the size of presentation material is reduced/enlarged in accordance with the 'width' and 'height' defined by a user in fig. 8.2. Further, this 'width' and 'height' can be set to 2 x 3½ as concedes by the applicant (last paragraph of page 8 in Remarks). Thus, the examiner notes that the technical feasibility alone supports the limitation's anticipation under the 102(a) rejection. It is respectfully noted that the examiner does not need to provide a usefulness of the cited reference when making a 102 rejection.

In response to applicant's argument regarding the rejection of **claims 1-3, 5, 7 and 11**, wherein on pages 10-12, the applicant states that current invention has, for example, "the step of creating a miniature printed version comprises creating a miniature printed version of the presentation materials in the size of a marketing product." Again, as applicant acknowledges in the Remark, the presentation material, according to Mucciolo, can be resized to a size of Banner. It is noted that the Banner is widely used as a marketing product. Further, both the letter paper and A4 paper are widely used in printing of advertisement. Further, the applicant agrees that, "PowerPoint also provides options for creating handouts for the audience to follow along with the presentation" (page 9). Since the examples provided in the Mucciolo reference, wherein on pages 179, 183 and 252-255, are the program and picture advertisements to the audience, and the slides are reduced and printed on papers, it is concluded that these "reduced" handouts are also used as the marketing products.

Further, the applicant states that Skarbo fails to teach the step of "packaging the miniature printed version of the presentation materials with a marketing product." The examiner disagrees. As set forth in the previous office action, fig. 3a discloses various information, such as name, company name, job title, and etc., on the BizCard. Since the information is used for advertising and marketing business, the information displayed/printed is a marketing product. Therefore, it would have been obvious to include the information of the presenter along with the presentation material. The motivation/suggestion for doing so would have been to present necessary information to the audiences to correctly advertise who presented the materials.

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In response to applicant's argument regarding the rejection of **claim 20**, wherein on pages 10-12, the applicant states that neither Stephen nor Mucciolo discloses a miniature version of a presentation presented by a person corresponding to the identification information on the first face. The examiner disagrees. Referring to fig. 1 and col. 4, lines 42-46 of Stephen, it clearly provides, thus presents, name, address, phone number, service, or product identification. Also, since Mucciolo teaches the method of reducing the size of presentation material to a size of a business card, Mucciolo cures the deficiency of Stephen.

3. Therefore, the rejections of **claims 1-5, 7-16 and 18-21**, as cited in the Office action dated 7/2/04, are maintained and repeated in the Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 12-15 and 18-20 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Mucciolo.

4. With respect to claim 12, Mucciolo discloses a computer implemented system for producing a miniature presentation, comprising:

a digital repository (memory) populated with presentation materials;

a processor; and

a computer readable medium encoded with processor readable instruction that when executed by the processor implement (first paragraph in page 178),

a selection mechanism configured to select a presentation to be reformed (page 124),

a reformatting mechanism configured to reformat the presentation as a miniature presentation (page 181-182), and

a printing mechanism configured to print the miniature presentation ('page setup option' in conjunction with 'handouts' option in page 180);

wherein the reformatting mechanism is further configured to reformat the presentation as a miniature presentation having the size of a business card.

It is inherent that PowerPoint of Mucciolo operates with operating system installed in a computer that has a memory and a processor.

Mucciolo teaches that PowerPoint provides a user with an option of customizing the size of slide, size of paper, orientation, and number of slides per page. It is also easily realized by one of ordinary skill in the PowerPoint art that by adjusting the size of the slide, the image or presentation printed on a paper is adjusted accordingly. On the other word, the size of presentation material is reduced/enlarged in accordance with the 'width' and 'height' defined by a user in fig. 8.2. Therefore, 'width' and 'height' can be reduced to the size of a business card, which has a dimension of 2 X 3½.

Therefore, claim 12 is clearly anticipated by Mucciolo.

5. With respect to claim 13, Mucciolo discloses the system of claim 12, wherein:
the digital depository further comprises a multiple frame animation (design templates of fig. 2.18 in page 40);

the selection mechanism is further configured to select the multiple frame animation for inclusion in the miniature presentation (page 124); and

the reformatting mechanism is further configured to combine the multiple frame animation and the presentation as a miniature presentation (page 178).

6. With respect to claim 14, Mucciolo disclose the system of claim 12, wherein:

the digital repository further comprises an image intended to facilitate recall of a message conveyed by the presentation materials (fig. 11.10 in pages 253);

the selection mechanism is further configured to select the image for inclusion in the miniature presentation (fig. 11.10 in pages 253); and

the reformatting mechanism is further configured to combine the image and the presentation as a miniature presentation (fig. 11.10 in pages 253).

Again, it is inherent that PowerPoint of Mucciolo operates with operating system installed in a computer that has a selection and reformatting mechanism to include images to the presentation material.

7. With respect to claim 15, Mucciolo discloses the system of claim 12, wherein:
the digital repository is further populated with foreign language version of the presentation materials (pages 737-738);

the selection mechanism is further configured to select a second version of the presentation in a foreign language (pages 737-738);

the reformatting mechanism is further configured to reformat the second version of the presentation for inclusion in the miniature presentation (pages 737-738).

Again, it is inherent that PowerPoint of Mucciolo operates with operating system installed in a computer that has a selection and reformatting mechanism to include foreign language to the presentation material.

8. With respect to claim 18, Mucciolo discloses a computer program product (PowerPoint), comprising:

a computer storage medium (memory) and a computer program code mechanism (PowerPoint) embedded in the computer storage medium for causing a processor to create a miniature printed version of presentation materials, the computer program code mechanism comprising:

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a first computer code device ('handouts' option) configured to reformat presentation materials into a miniature version of the presentation materials (page 180); and

a second computer code device ('print' option) configured to print the miniature version of the presentation materials (page 180);

wherein the miniature version of the presentation materials has the size of a business card.

Also, arguments analogous to those presented for claim 12, are applicable.

9. With respect to claim 19, Mucciolo discloses the computer program product of claim 18, wherein the first computer code device further comprises a third computer code device ('add clip art' option in page 250) configured to include other information when reformatting the miniature version of the presentation materials (fig. 11.10 in pages 253).

10. With respect to claim 20, arguments analogous to those presented for claims 12 and 18, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mucciolo in view of Skarbo.

11. With respect to claim 1, Mucciolo teaches a method for conveying a message to an audience comprising the steps of:

creating presentation materials (first paragraph in page 178);

creating a miniature printed version (slide 1 shown in 'handouts' option window) of the presentation materials ('page setup option' in conjunction with 'handouts' option in page 180);

presenting presentation materials to the audience; and

providing the audience with the miniature printed version of the presentation materials ('printing PowerPoint presentations' in page 180);

wherein the step of creating a miniature printed version comprises creating a miniature printed version of the presentation materials in the size of a marketing product ('page setup' in page 180).

Mucciolo teaches that PowerPoint provides a user with an option of customizing the size of slide, size of paper, orientation, and number of slides per page. It is also easily realized by one of ordinary skill in the PowerPoint art that by adjusting the size of the slide, the image or presentation printed on a paper is adjusted accordingly. On the other word, the size of presentation material is reduced/enlarged in accordance with the 'width' and 'height' defined by a user in fig. 8.2. Therefore, 'width' and 'height' can be reduced to the size of a business card, which has a dimension of 2 X 3½.

However, Mucciolo does not teach explicitly *a step of packaging the miniature printed version of the presentation materials with a marketing product.*

Skarbo teaches a method for creating a business card comprising the steps of:
creating presentation materials (visual presentation 39g and other information 39
in BIZCARD in fig. 3a); and

presenting presentation materials to the audience (presenting BIZCARD to
conference participants in col. 1, line 67); wherein

a step of packaging the presentation materials with a marketing product
(BIZCARD having all of presentation materials in fig. 3b).

Mucciolo and Skarbo are analogous art because they are from the same field of
endeavor that is presentation art.

Since presenting presentation materials during a conference by using
PowerPoint is widely used method, thus a well known method, at the time of the
invention, it would have been obvious to one of ordinary skill in the art to combine the
presentation materials of BIZCARD taught by Skarbo with the Powerpoint printing
method of Mucciolo.

The suggestion/motivation for doing so would have been to present necessary
information to the conference participants (audiences) in electronic business card
format (BIZCARD), which can be further printed using PowerPoint printing technique.

Therefore, it would have been obvious to combine Mucciolo with Skarbo to obtain
the invention as specified in claim 1.

12. With respect to claim 2, Mucciolo teaches the method of claim 1, wherein the step of creating a miniature version comprises creating a miniature printed version of the presentation materials as a single printed page ('handout' option in page 180). The user has an option of setting "slides per page" equal to the number of presentation slides to create a single printed page.

13. With respect to claim 3, Mucciolo teaches the method of claim 1, wherein the step of creating a miniature version comprises creating a miniature printed version of the presentation materials as a plurality of printed pages ('handout' option in page 180). Again, the user has an option of setting "slides per page" to create presentation material in a plurality of printed pages.

14. With respect to claim 5, as noted above, arguments analogous to those presented for claim 1, are applicable. Please refer to the last limitation of claim 1.

15. With respect to claim 7, Skarbo teaches that the marketing product is a business card (BIZCARD).

16. With respect to claim 11, Mucciolo further teaches the step of creating a miniature printed version step comprises including an image intended to facilitate recall of a message conveyed by the presentation materials on the miniature printed version of the presentation materials (design templates of fig. 2.18 in page 40). It is inherent that PowerPoint of Mucciolo is operated with operating system installed in a computer that has a selection and reformatting mechanism to include images to the presentation material upon the user preferences.

Furthermore, Skarbo teaches the step of including visual presentation (picture 39a of the person) in the presentation, BIZCARD, which is obviously intended to facilitate recall of a message conveyed by the presentation material.

Claims 4, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mucciolo and Skarbo as applied to claim 3 above, and further in view of Pirrello U.S. Patent No. 5,685,568.

17. With respect to claim 4, the combination of Mucciolo and Skarbo teaches the method of claim 3 but it does not teach explicitly the step of binding the plurality of printed pages together.

Pirrello teaches the method of binding a plurality of printed pages together (figs. 2 & 3; col. 4, lines 48-55).

Mucciolo, Skarbo, and Pirrello are analogous art because they are from the same field of endeavor that is presenting presentation art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of binding a plurality of printed material with presentation method of Mucciolo and Skarbo.

The suggestion/motivation for doing so would have been to organize the printed presentation material by binding them together.

Therefore, it would have been obvious to combine all three inventions to obtain the invention as specified in claim 4.

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18. With respect to claim 9, the combination of Mucciolo, Skarbo and Pirrello teaches the method of claim 4, wherein:

the step of creating a miniature printed version comprises including at least one transparent page containing emphasis material (lines 7-8, page 178 of Mucciolo); and

the step of packaging comprises packaging the at least one transparent page adjacent to a page that will be emphasized by overlaying the at least one transparent page (binding method of Pirrello).

Mucciolo teaches a method of printing the presentation materials in a transparent page when it is sent to create overheads. Additionally, it is well known to one of ordinary skill in the art that printing a presentation material on a transparent sheet would draw more attention to the audience when the rest of presentation material is printed on ordinary sheets.

19. With respect to claim 10, Pirrello teaches a method of providing a protective sleeve for printed version of the presentation materials (col. 3, lines 14-30).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mucciolo and Skarbo as applied to claim 5 above, and further in view of Pirrello.

20. With respect to claim 8, the combination of Mucciolo and Skarbo teaches the method of claim 5.

Mucciolo further teaches the method of creating a miniature printed version comprises including a multiple frame animation (design templates of fig. 2.18 in page 40) on the miniature printed version of the presentation materials.

The combination, however, does not explicitly teach the method of viewing the multiple frame animation by flipping through the miniature printed version of the presentation materials.

Pirrello teaches a method of viewing a plurality of presentation materials by flipping through the printed version of the presentation materials (figs. 2 & 3; col. 4, lines 48-55).

Mucciolo, Skarbo, and Pirrello are analogous art because they are from the same field of endeavor that is presentation material art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of binding a plurality of printed material with presentation method of Mucciolo and Skarbo.

The suggestion/motivation for doing so would have been to organize the printed presentation material by binding them together and thus providing the audience with a convenience of viewing the printed presentation materials by flipping them.

Therefore, it would have been obvious to combine all three inventions to obtain the invention as specified in claim 8.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mucciolo as applied to claim 15 above, and further in view of Stephen U.S. Patent No. 6,192,117.

21. With respect to claim 16, Mucciolo discloses the system of claim 15 but it does not explicitly disclose the system configured to print on both sides of the miniature presentation.

Stephen discloses a presentation (business card) printing system that prints on both sides of the presentation (figs 1 & 2).

Stephen and Mucciolo are analogous art because they are from the same field of endeavor that is the presentation/document printing art.

Since Mucciolo discloses a system that can reduce the size of the presentation to a size of business card, it would have been obvious to combine the system for printing on both sides of the presentation of Stephen with the system for creating miniature version of presentation of Mucciolo.

The suggestion/motivation for doing so would have been to save printing medium by utilizing both sides of the printing medium.

Therefore, it would have been obvious to combine Stephen with Mucciolo to obtain the invention as specified in claim 16.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephen in view of Mucciolo.

22. With respect to claim 21, Stephen disclose a business card comprising:

a first face ; and

a second face, wherein,

said first face has printed thereon identification information corresponding to a person (fig. 1), and

said second face has printed thereon a presentation (phone card in fig. 2) presented by the person corresponding to the identification information on the first face.

Although reducing an image or presentation material such as phone card information is well known in the document processing art, Stephen does not explicitly disclose that the printed presentation is a miniature version.

Mucciolo, however, discloses that a document can be reduced to any size and thus miniature version of a printed presentation is provided ('page setup option' in conjunction with 'handouts' option in page 180).

Stephen and Mucciolo are analogous art because they are from the same field of endeavor that is the presentation/document printing art.

The suggestion/motivation for doing so would have been to reduce the size of presentation when the paper to be used in printing is smaller than the actual presentation document.

Therefore, it would have been obvious to combine Stephen with Mucciolo to obtain the invention as specified in claim 21.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
April 18, 2005

Chan S. Park
Examiner
Art Unit 2622


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